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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,406	08/01/2003	Clifford H. Kraft		2935
7590 07/22/2009				
Clifford Kraft 320 Robin Hill Dr. Naperville, IL 60540			EXAMINER GARY, ERIKA A	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 07/22/2009	DELIVERY MODE PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CLIFFORD H. KRAFT

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Appeal 2009-002577  
Application 10/632,406  
Technology Center 2600

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Decided:<sup>1</sup> July 22, 2009

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Before JOSEPH F. RUGGIERO, MARC S. HOFF,  
and THOMAS S. HAHN, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of claims 21-25.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's invention relates to a mobile telephone locating service. Subscribers may locate a particular mobile telephone handset on demand. The handset owner may make a selection at the handset (so-called "privacy mode") such that his handset location is not provided to requesting subscribers. Further, by providing appropriate information such as a password or PIN, a subscriber may be provided with a particular handset's location even when the handset has been set to privacy mode (Spec. 2, 3, 7).

Claim 21 is exemplary:

21. A telephone location system comprising:  
a plurality of mobile telephone handsets;

a telephone service provider providing telephone location services in communication with said at least one of said mobile telephone handsets wherein, said telephone service provider geographically locates said mobile telephone handset, a handset owner being able to block location of said handset for a time duration determined by said handset owner by an action taken by said handset owner directly on said handset, said action causing said handset to send a message to said telephone service provider, wherein said telephone service provider blocks location determination;

said telephone service provider accepting a request from a consumer to locate a particular mobile telephone handset, said telephone service provider determining a geographic location of said particular mobile telephone handset when said user allows such determination; said telephone service provider than communicating said mobile telephone handset location to said consumer;

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<sup>2</sup> Claims 1-20 have been cancelled.

wherein said mobile telephone handset location is returned to said consumer in relational form by written description and shown on a map; and

wherein a particular consumer, by sending a predetermined message to said telephone service provider, can cause said telephone service provider to locate said mobile telephone handset even when said handset owner has blocked location of said mobile telephone handset.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Herle	US 2003/0035544 A1	Feb. 20, 2003
Ross	US 2003/0236095 A1	Dec. 25, 2003
Wilson	US 2004/0203903 A1	Oct. 14, 2004

Claims 21-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Herle in view of Ross and Wilson.

Throughout this decision, we make reference to the Appeal Brief (“App. Br.,” filed Nov. 7, 2007), the Reply Brief (“Reply Br.,” filed Feb. 29, 2008) and the Examiner’s Answer (“Ans.,” mailed Dec. 28, 2007) for their respective details.

## ISSUES

Appellant argues that (a) the cited references do not teach the ability of the handset owner to block location determination by an action at the handset, where that action sends a message to the telephone provider such that the provider will block provision of the handset’s location to requesting customers (App. Br. 14); (b) the cited references do not teach providing a predetermined message to the telephone provider, in response to which the provider will provide a handset’s location despite the handset owner’s setting blocking location determination (App. Br. 15); (c) that Ross and

Wilson teach away from each other, and both teach away from Appellant's invention, because of their distinct privacy schemes (App. Br. 16-17); and (d) that the cited references do not teach providing handset location to the consumer in relational form by written description (Reply Br. 2).

Appellant's contentions present us with the following four issues:

1. Has Appellant shown that the Examiner erred in finding that the combination of Herle, Ross, and Wilson teaches that a handset owner may set a "privacy mode" at the handset, causing a message to be sent to the telephone provider instructing the provider not to provide handset location information to requesting customers?

2. Has Appellant shown that the Examiner erred in finding that Herle in combination with Ross and Wilson teaches the ability of a customer to override a handset owner's invocation of privacy mode by providing an appropriate predetermined message to the telephone service provider?

3. Has Appellant shown that the Examiner erred in combining Herle with Ross and Wilson to obtain the instant invention, because Ross's privacy scheme teaches away from Wilson's, and because both teach away from Appellant's privacy scheme?

4. Has Appellant shown that the Examiner erred in finding that Herle, Ross, and Wilson together teach or fairly suggest providing telephone handset location information in relational form by written description?

### FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

#### *The Invention*

1. According to Appellant, the invention concerns a mobile telephone locating service. A handset owner may make a selection at the handset (so-called “privacy mode”) such that his handset location is not provided to requesting subscribers. Further, by providing appropriate information such as a password or PIN, a subscriber may be provided with a particular handset’s location even when the handset has been set to privacy mode (Spec. 2, 3, 7).

#### *Herle*

2. Herle teaches providing location “only to those having authorization from the mobile station user” (¶ 0036).

3. Herle teaches overriding that default setting upon the provision by a requesting person to the telephone service provider of a “predetermined message,” i.e., the proper decryption key (¶¶ 0036, 0037).

#### *Ross*

4. Ross teaches acquiring, processing, and using wireless device location information, including displaying that location information on a map (¶¶ 0001, 0019).

#### *Wilson*

5. Wilson teaches that a stop request made by a handset owner results in the updating of a central database, prohibiting other mobile devices from receiving location information with respect to that handset (Abstract, ¶ 0157).

6. Wilson teaches user-selectable invisibility for a time duration (§ 0158, Fig. 40).

7. Wilson teaches a device in which a user may define certain “friends” prohibited from receiving location information, *and* may define certain time periods in which location information will not be provided, *and* may define locations within which location information will not be provided (Fig. 40, §§ 0156-0162).

8. Wilson teaches, within a system for providing location-based services, providing a friend’s (handset) location, as an address location, to a user upon request (§§ 0090, 0091; see also §§ 0037, 0050).

9. Wilson further teaches embodiments in which a user is provided with a list of cross streets near a location (§ 0101), or SMS notification when a friend on the user’s list is “nearby” (§ 0102).

## PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has stated that “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419-420.

The determination of obviousness must consider, *inter alia*, whether a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so. *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000). *Medichem. S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006). Where the teachings of two or more prior art references conflict, the Examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Further, our reviewing court has held that “[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994); *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.*, 73 F.3d 1085, 1090 (Fed. Cir. 1995).

## ANALYSIS

We select claim 21 as representative of the claims on appeal, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that the Examiner’s combination of references does not teach the ability of the handset owner to block location of the handset for



a time duration determined by the handset owner by an action taken directly on the handset, where the action sends a message to the telephone provider and the provider blocks the location (App. Br. 14).

We are not persuaded by Appellant's argument. As found by the Examiner (Ans. 7), Wilson teaches that a stop request made by the handset owner results in the updating of a central database, prohibiting other mobile devices from receiving location information with respect to that handset (FF 5). Wilson further teaches user-selectable invisibility for a time duration (FF 6).

Appellant further argues that the combination of Wilson, Herle, and Ross fails to teach sending a predetermined message to the telephone service provider that causes the provider to locate the handset even when the handset owner has blocked location determination (App. Br. 15).

We disagree. Herle teaches providing location "only to those having authorization from the mobile station user" (FF 2). The default setting in Herle, thus, is *not* to provide the mobile station's location to a requesting person – in other words, to block the provision of location information. Herle teaches overriding that default setting upon the provision by a requesting person to the telephone service provider of a "predetermined message," i.e., the proper decryption key (FF 3).

Appellant argues that Ross's teaching of a location-oriented privacy zone teaches away from Wilson's teaching of handset-related privacy, and that both teach away from the time-related privacy scheme of Appellant's invention (App. Br. 16-17).

Appellant's argument is not convincing of Examiner error. We agree with the Examiner that Wilson and Ross both teach managing location

information of mobile communication devices, including privacy or location blocking features (Ans. 10). Further, Appellant has provided no reasons why the privacy options taught by Ross and Wilson (and/or those disclosed by Appellant) could not simultaneously be offered in the same device. In fact, Wilson teaches just such a device, in which a user may define certain “friends” prohibited from receiving location information, *and* may define certain time periods in which location information will not be provided, *and* may define locations within which location information will not be provided (FF 7). We regard Wilson’s provision of all these features as persuasive evidence that the features are not mutually incompatible.

Finally, Appellant argues that the Examiner’s rejection is erroneous because the applied references (Ross, specifically) do not teach mobile telephone handset location being returned to the consumer in relational form by written description (Reply Br. 2). We are not persuaded by Appellant’s argument. While we agree with Appellant that Ross does not specifically disclose providing a location in written form, Wilson does teach, within a system for providing location-based services, providing a friend’s (handset) location, as an address location, to a user upon request (FF 8). Wilson further teaches embodiments in which a user is provided with explicitly “relational” information, such as a list of cross streets near a location (FF 9), or SMS notification when a friend on the user’s list is “nearby” (FF 9). We concur in the Examiner’s rationale that it would have been obvious to provide various forms of location information (e.g., written description and map display) because different forms suit different users (Ans. 5).

Accordingly, because Appellant has not shown error in the Examiner's rejection of claim 21, we will sustain the rejection of claims 21-25 under 35 U.S.C. § 103(a).

#### CONCLUSIONS OF LAW

1. Appellant has not shown that the Examiner erred in finding that the combination of Herle, Ross, and Wilson teaches that a handset owner may set a "privacy mode" at the handset, causing a message to be sent to the telephone provider instructing the provider not to provide handset location information to requesting customers.

2. Appellant has not shown that the Examiner erred in finding that Herle in combination with Ross and Wilson teaches the ability of a customer to override a handset owner's invocation of privacy mode by providing an appropriate predetermined message to the telephone service provider.

3. Appellant has not shown that the Examiner erred in combining Herle with Ross and Wilson to obtain the instant invention, because Ross's privacy scheme teaches away from Wilson's, and because both teach away from Appellant's privacy scheme.

4. Appellant has not shown that the Examiner erred in finding that Herle, Ross, and Wilson together teach or fairly suggest providing telephone handset location information in relational form by written description.

#### ORDER

The Examiner's rejection of claims 21-25 under 35 U.S.C. § 103(a) is affirmed.

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Application 10/632,406

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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